



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/039,537 | 01/04/2002 | Dietrich W. Schultz | 21540-05742 | 9387 |

758 7590 05/18/2005

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

| |
|----------|
| EXAMINER |
|----------|

VAUGHN, GREGORY J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2178

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/039,537 | Applicant(s) SCHULTZ ET AL. | |
| | Examiner Gregory J. Vaughn | Art Unit 2178 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/31/05</u> . | 6) <input type="checkbox"/> Other: _____ |

[Handwritten signature]

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, filed on 3/7/2005.
2. Applicant has amended claims 1-15, 17, 19, 20 and 22 and added new claims 23-25.
3. Claims 1-25 are pending in the case, claims 1, 10 and 17 are independent claims.
4. Applicant has amended the specification in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 12/2/2004). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the drawings and specification are withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."
6. Claims 1, 10, 17 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in

Art Unit: 2178

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. **Regarding claims 1, 10 and 17**, the amendment filed 3/7/2005 adds the following limitations: *"determining a context of the document; and modifying, responsive to the context, the document to generate a modified document"* (fourth and fifth limitations). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
8. **Regarding claims 23-25**, the amendment filed 3/7/2005 adds the following limitations: *"wherein the context comprises one of a group containing a page preview, a local publish, an external publish, a local stage, and an external stage"*. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

10. Claims 1-22 remain rejected and claims 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bernardo et al. US Patent 6,684,369, filed 6/19/1998, patented 1/27/2004 (hereinafter Bernardo).

11. **Regarding independent claim 1**, Bernardo discloses a computer-implemented method of generating a document. Bernardo recites: *"One embodiment of the invention provides a tool, system and method for creating Web sites"* (column 5, lines 29-30), where Bernardo defines "web sites" as: *"For example, FIG. 5 depicts the feature of Web site areas. As shown in FIG. 5, the site area options may include a list of predefined site areas such as Company Forms Area, Contact Management Area, Customer Tracking Area, Discussion Area, Document Library Area"* (column 7, lines 26-30).

Bernardo discloses a first user interface used to generate a document template. Bernardo recites: "*A conventional editor may be used to edit HTML objects within the system. A conventional technique (e.g., a computer gateway interface (CGI)) may be used to store the edited HTML objects in the HTML database*" (column 6, lines 10-14).

Bernardo discloses in Figure 3, a second user interface (see reference sign 4, shown as "*Identify Interface*"), which is used to generate document content (see reference sign 16, shown as "*Enter Data*"). Bernardo discloses the functionality of the second user interface as being determined by a user other than the second user. Bernardo recites: "*Another object of the invention is to provide a tool for creating a Web site where the tool comprises a library of stored templates (including fields) associated with different options/features for a Web site, the tool prompts a user of the tool to select desired options/features from a list of possible options/features. Based upon the option/features selected, the tool determines which of the stored templates (and fields) are to be used and the user is prompted to supply data to populate those fields*" (column 2, lines 49-57).

Bernardo discloses in Figure 3, combining the template and the content to generate the document at reference sign 20 (shown as "*Populate Profile Fields with Data*") and reference sign 22 (shown as "*Create Pages*") and reference sign 24 (shown as "*Publish*").

Bernardo discloses the determination of the context of the document and modifying the document based upon the context. Bernardo recites: "*The help*

documents are preferably HTML documents created from one or more of the templates. The help documents include fields that link the document with one or more related fields of other templates to associate each help document with one or more features and/or fields. In this way, context-sensitive help can be provided" (column 13, lines 42-48).

12. **Regarding dependent claim 2**, Bernardo discloses the functionality of the second user interface as being determined by the first user. Bernardo recites: *"Another object of the invention is to provide a tool for creating a Web site where the tool comprises a library of stored templates (including fields) associated with different options/features for a Web site, the tool prompts a user of the tool to select desired options/features from a list of possible options/features. Based upon the option/features selected, the tool determines which of the stored templates (and fields) are to be used and the user is prompted to supply data to populate those fields"* (column 2, lines 49-57).

13. **Regarding dependent claim 3**, Bernardo discloses a first server in Figure 1 at reference sign 114 (shown as "Server") where the template and content are stored. Bernardo further discloses a second server where the document is stored after the template and content are combined. Bernardo recites: *"Once the approval process is complete, routing module may, at step 24, send the approved (and possibly revised) Web site/pages to server 30 for posting on a network"* (column 8, lines 24-27)

Art Unit: 2178

14. **Regarding dependent claim 4**, Bernardo discloses a second user interface that provides functionality to create content related to the template specified by a first user. Bernardo discloses in Figure 3, a second user interface (see reference sign 4, shown as *"Identify Interface"*), which is used to generate document content (see reference sign 16, shown as *"Enter Data"*). Bernardo discloses the functionality of the second user interface as being determined by a user other than the second user. Bernardo recites: *"Another object of the invention is to provide a tool for creating a Web site where the tool comprises a library of stored templates (including fields) associated with different options/features for a Web site, the tool prompts a user of the tool to select desired options/features from a list of possible options/features. Based upon the option/features selected, the tool determines which of the stored templates (and fields) are to be used and the user is prompted to supply data to populate those fields"* (column 2, lines 49-57).
15. **Regarding dependent claim 5**, Bernardo discloses a second user interface (as described above) that prevents the second user from creating content files related to a second document template. Bernardo discloses in Figure 3 at reference sign 6 (shown as *"Present Options/Features"*) features that prevent the second user from creating content files that are not specified by the first user.

Art Unit: 2178

16. **Regarding dependent claim 6**, Bernardo discloses a first user interface used to generate a document template. Bernardo recites: "*A conventional editor may be used to edit HTML objects within the system. A conventional technique (e.g., a computer gateway interface (CGI)) may be used to store the edited HTML objects in the HTML database*" (column 6, lines 10-14).
17. **Regarding dependent claim 7**, Bernardo discloses a template that defines what content data is entered in Figure 13, shown as an "*approval message*" text entry area on the template shown in the figure.
18. **Regarding dependent claim 8**, Bernardo discloses a second user interface as described above. Bernardo also discloses the template defines the functionality available through the second user interface. Bernardo recites: "*The tool further comprises a library of templates (e.g., text, fields, HTML code and formulas) that correspond to the available features and options*" (column 6, lines 34-37).
19. **Regarding dependent claim 9**, Bernardo discloses receiving data defining the content in Figure 8, shown as the "*Text Color*" selection option.
20. **Regarding independent claims 10 and 17**, the claims are directed toward a system and a method for the method of claim 1 and are rejected using the same rationale.

Art Unit: 2178

21. **Regarding dependent claims 11 and 18**, the claims are directed toward a system and a method for the method of claim 2 and are rejected using the same rationale.
22. **Regarding dependent claim 12**, the claim is directed toward a system for the method of claim 4, and is rejected using the same rationale.
23. **Regarding dependent claim 13**, the claim is directed toward a system for the method of claim 6, and is rejected using the same rationale.
24. **Regarding dependent claims 14 and 20**, the claims are directed toward a system and a method for the method of claim 7 and are rejected using the same rationale.
25. **Regarding dependent claim 15**, the claim is directed toward a system for the method of claim 8, and is rejected using the same rationale.
26. **Regarding dependent claim 16**, Bernardo discloses a file manager module in Figure 1A at reference sign 138 (shown as "*Workflow Module*"). Bernardo discloses storing a relationship between the template and the content file in Figure 1 at reference sign 166a (shown as "*Link*").
27. **Regarding dependent claim 19**, the claim contains substantially the same subject matter as claims 4 and 8 combined and is rejected using the same rationale.

Art Unit: 2178

28. **Regarding dependent claim 21**, Bernardo discloses content received from a second user. Bernardo recites: *"Another object of the invention is to provide a tool for creating a Web site where the tool comprises a library of stored templates (including fields) associated with different options/features for a Web site, the tool prompts a user of the tool to select desired options/features from a list of possible options/features. Based upon the option/features selected, the tool determines which of the stored templates (and fields) are to be used and the user is prompted to supply data to populate those fields"* (column 2, lines 49-57).
29. **Regarding dependent claim 22**, the claim contains substantially the same subject matter as claim 4, and is rejected using the same rationale.
30. **Regarding dependent claim 23**, Bernardo discloses the context as a local stage. Bernardo recites: *"the content creator may be presented with context sensitive help pages"* (column 13, lines 21-22).
31. **Regarding dependent claims 24 and 25**, the claims are directed toward a system and a method for the method of claim 23 and are rejected using the same rationale.

Response to Arguments

32. Applicant's arguments filed 3/7/2005 have been fully considered but they are not persuasive.

33. **Regarding claim 1**, the applicant recites: *"the document is "published" by making it available from a user server. Optionally, the document can be "staged" (e.g., before it is "published") by making it available from a staging server. Staging enables the document to be previewed before it is made available from the user server. If the user server or staging server is on the same server as the edit server, this is known as a local publish or local stage, respectively. If the user server or staging server is on a different server as the edit server this is known as an external publish or external stage, respectively. In one embodiment, after the document has been generated, a user can "preview" it which is called "page preview" (page 13, first paragraph of the amendment filed 3/7/2005). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the document is published", "a user server", "the document can be staged", "a staging server", "document to be previewed", "edit server", "local publish or local stage" and "a user can preview it, which is called page preview") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).*

Art Unit: 2178

34. **Regarding claim 1**, the applicant recites: "*Bernardo does not disclose, suggest, or teach the claimed elements "determining a context of the document" and "modifying, responsive to the context, the document"* (page 13, first paragraph of the amendment filed 3/7/2005). Applicant is directed to the rejection of claim 1 as restated above, where Bernardo discloses determining the context of a document, and modifying the document.

Conclusion

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
May 13, 2005



STEPHEN HONG
SUPERVISORY PATENT EXAMINER